



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,537	07/29/2003	Sandeep Bhatia	CA7034222001	9252
23639	7590	07/26/2006	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067			CHUNG, PHUNG M	
			ART UNIT	PAPER NUMBER
			2138	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,537

Applicant(s)

BHATIA, SANDEEP

Examiner

Phung My Chung

Art Unit

2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-18 and 24-27 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102 (e)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-14 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Quayle et al (6,694,464).

As per claims 10-11, Quayle et al disclose an apparatus, comprising:

A mean for dividing pins of an integrated circuit into a first group and a second group;

A means for logically associating each pin of the first group to each pin of the second group; and

A means for generating a scan chain in the integrated circuit for each logical association of pins. (See Fig. 11, col. 16, lines 50-65 and col. 17, lines 42-67 to col. 18, lines 1-25).

As per claim 12, Quayle et al further disclose, wherein the first group has n numbers of pins (1804 PINS), the second group has m number of pins (1868 PINS), and the logical association of pins drives $n*m$ scan chains. (See Fig. 11).

As per claims 13-14, Quayle et al further disclose wherein the means for logically associating comprises:

A means for performing a exclusive OR operation (col. 47, lines 14-49).

As per claims 1-5 and 6-9, these method claims are rejected under similar rationale as set forth in system claims 10-14.

As per claims 19-23, these claims are rejected under similar rationale as set forth in claims 10-14.

Claim Rejections - 35 USC § 102(b)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 10-12 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sample et al (6,377,912).

As per claims 10-11, Sample et al disclose an apparatus, comprising:

A mean for dividing pins of an integrated circuit into a first group and a second group;

A means for logically associating each pin of the first group to each pin of the second group; and

A means for generating a scan chain in the integrated circuit for each logical association of pins. (See Fig. 11, col. 14, lines 20-67 and col. 15, lines 1-62).

As per claim 12, Sample et al further disclose, wherein the first group has n numbers of pins (1804 PINS), the second group has m number of pins (1868 PINS), and the logical association of pins drives $n*m$ scan chains. (See Fig. 11).

As per claims 19-21, these claims are rejected under similar rationale as set forth in claims 10-12.

Allowable Subject Matter

5. Claims 15-18 and 24-27 are allowable.

6. Applicant's arguments filed on 5/5/06 have been fully considered but they are not persuasive because:

Applicant argues that Quayle would not teach or suggest logically associating each pin of the first group to each pin of the second group.

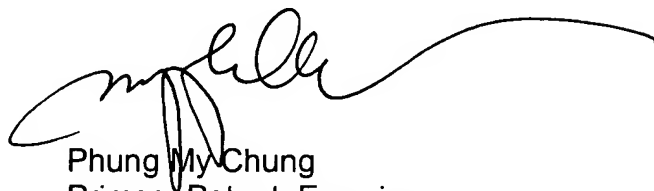
Examiner disagrees with applicant because Quayle does suggest logically associating each pin the first group to each pin of the second group thru MUXs by logic chips in Fig. 11.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2138

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phung My Chung', with a long horizontal flourish extending to the right.

Phung My Chung
Primary Patent Examiner
Art Unit 2138